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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,560	08/28/2003	Eric D. Fox	073897.0140	7600

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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,560

Applicant(s)

FOX, ERIC D.

Examiner

Mark T Henderson

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3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 3-5, 10-12, 19, 21, 22, 25-30, 35, 37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6-8, 13, 16, 17, 23, 24, 31, 39 is/are rejected.
- 7) ☒ Claim(s) 9, 14, 15, 18 and 32-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 3-5, 10-12, 19, 21, 22, 25-30, 35, 37, and 38 have been withdrawn from further consideration. Claims 1, 7, 15, 16, and 23 have been amended for further examination.

Election/Restriction

2. This application contains claims 3-5, 10-12, 19-22, 25-30, 35-38 and 40 are drawn to an invention nonelected with traverse in Paper No. 6/18/04. A complete reply to the final rejection

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must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 6 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al (5,777,305)

Smith et al discloses in Fig. 1-3, a card product comprising providing a card (1) having a recess (17, as stated in Col. 3, lines 15 and 16) disposed within the card and operable for receiving and removing an item (3); a magnetic stripe (11) disposed on the card separate from a location of the recess disposed within the card, wherein the magnetic stripe is operable to store information; and wherein a portion (5) of the card (seen in Fig. 1) is at least partially transparent to make the item (3) visible through the face of the card.

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In regards to the identification card being operable to identify the cardholder and issuer, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Therefore, the card of Smith et al is capable of being operable to identify the cardholder and issuer.

4. Claims 1, 2, 6-8, 13, 16, and 17 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Gunn (5,503,434).

Gunn discloses in Fig. 1, 2, 5 and 34, an identification card (180) and a method of securing an item comprising having a recess or cavity (182 as seen in Fig. 34) disposed within the card on a first face (180A) and operable for receiving and removing an item (as stated in Col. 9, lines 8-12); a magnetic stripe (54) disposed on the card separate from a location of the recess disposed within the card, wherein the magnetic stripe (54) is operable to store information; a transparent cover portion (184) adhesively secured (Col. 9, line 14) to the card and wherein a portion (5) of the card (seen in Fig. 1) is at least partially transparent to make the item (3) visible through the face of the card.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 23, 24, 31 and 39 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Gunn in view of Rubincam.

Gunn discloses in Fig. 1, 2, 5 and 34, an identification card (180) and a method of securing an item or insert (such as a photograph or visual readable means) comprising having a recess or cavity (182 as seen in Fig. 34) disposed within the card on a first face (180A) and operable for receiving and removing an item (as stated in Col. 9, lines 8-12); a magnetic stripe (54) disposed on the card separate from a location of the recess disposed within the card, wherein the magnetic stripe (54) is operable to store information; a transparent cover portion (184) adhesively secured (Col. 9, line 14) to the card and wherein a portion (5) of the card (seen in Fig. 1) is at least partially transparent to make the item (3) visible through the face of the card.

However, Gunn does not disclose: wherein the insert is coupleable to a picture to permit the picture to be inserted and removed from the recess.

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Rubincam discloses in Fig. 3, an insert (30) coupleable to a picture (32, as stated in Col. 2, lines 47-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gunn's card with an insert that is coupleable to a picture as taught by Rubincam for providing an insert having a picture which can be interchangeable.

Allowable Subject Matter

6. Claim 9, 14, 15, 18, and 32-34 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art References

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. McIntire et al, Martin, Metzger and Riley disclose similar identification cards.

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Response to Arguments

7. Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection.

The examiner has used the Smith et al reference to reject Claims 1 and 6. Smith et al disclose a card having a recess (which is formed through the sheath (15)), a magnetic strip, and a transparent portion. The examiner has also used the Gunn reference which discloses an identification card having a recess, a magnetic strip and a transparent cover. The examiner's rejection have been maintained.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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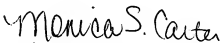
will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571)272-4477. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Derris Banks, can be reached on (571) 272-4419. The fax number for TC 3700 is (703)-872-9306.


MTH

February 18, 2005


MONICA S. CARTER
PRIMARY EXAMINER